



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,534	01/16/2001	Hiroshi Ishizuka	1081.1103 (JDH)	2120
21171	7590	04/10/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			GART, MATTHEW S	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,534

Applicant(s)

ISHIZUKA ET AL.

Examiner

Matthew S. Gart

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4,12,14,16,20 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,4,12,14,16,20 and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Prosecution History Summary

- The applicant previously canceled claims 1-2, 5-11, 13, 15, 17-19 and 21.
- Claim 27 was added via the applicant's response filed 3/6/2006.
- Claims 3-4, 12, 14, 16, 20 and 22-27 are pending and under consideration.

Election/Restrictions

Newly submitted claim 27 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claim 27 is directed towards a method of selecting a commodity based on a user's need, comprising allowing the user to select a commodity from a list of commodities that meets the user's need and providing information of the commodity including usability of the commodity with other commodities. Claim 27 requires a different field of search than any other claim presently under consideration, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 27 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 16 is rejected under 35 U.S.C. 101.

Referring to claim 16. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute “descriptive material.” Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function

Art Unit: 3625

of the descriptive material to be realized. Claim 16 fails to recite a computer program that is embodied on a computer-readable medium. The claim is merely directed to a computer program per se.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 3-4, 12, 14, 16, 20 and 22-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Puri (U.S. Patent No. 6,064,982).

Referring to claim 3. Puri discloses a commodity retrieval method in a commodity sale transaction via a network (Puri: FIG. 1, “12”), the method comprising:

- Displaying objects of use of commodities on a user’s terminal (Puri: FIG. 4, “50”);
- Preparing a table indicative of correspondence between the objects of use and specifications required to attain the commodities (Puri: FIG. 5, “60” and column 5, lines 26-31);
- Acquiring a specification corresponding to at least one object of use selected by a user via the terminal from the table, the user selecting the at least one object of use from the displayed objects of use of the commodities (Puri: FIG. 7, “81”);
- Retrieving the commodities based on the acquired specification as a retrieval condition (Puri: FIG. 9); and
- Displaying, on the terminal, information on a commodity having specifications corresponding to the selected object of use without requiring the user’s

Art Unit: 3625

knowledge of specifications corresponding to the at least one object of use selected by the user (Puri: FIG. 9).

Referring to claim 4. Puri further discloses a method wherein the network is Internet (Puri: column 2, line 61 through column 3, line 9).

Referring to claim 12. Claim 12 is rejected under the same rationale as set forth above in claims 3-4.

Referring to claim 14. Claim 14 is rejected under the same rationale as set forth above in claims 3-4.

Referring to claim 16. Claim 16 is rejected under the same rationale as set forth above in claims 3.

Referring to claim 20. Claim 20 is rejected under the same rationale as set forth above in claims 3.

Referring to claim 22. Claim 22 is rejected under the same rationale as set forth above in claims 3.

Referring to claim 23. Claim 23 is rejected under the same rationale as set forth above in claims 3.

Referring to claim 24. Claim 24 is rejected under the same rationale as set forth above in claims 3.

Referring to claim 25. Claim 25 is rejected under the same rationale as set forth above in claims 3.

Referring to claim 26. Puri discloses a commodity retrieval method for a commodity sales transaction, comprising:

Art Unit: 3625

- Storing attribute information of commodities available for sale and displaying an object of use for each of the commodities for sale based on the stored attribute information (Puri: FIG. 4); and
- Enabling a user to make a selection from the displayed object of use (Puri: FIG. 4) and providing information of a corresponding commodity to the user based on the selection of the object of use (Puri: FIG. 5).

Response to Arguments

Applicant's arguments with respect to all the pending claims have been considered but are not persuasive.

The Applicant argues that Puri only recommends the way a system already selected by a customer is set up (i.e., number of users, components of the products, etc.) and does not select the product itself based on the customer need.

The Examiner notes, FIG. 5 of Puri is an illustration of a product choice page for the smart configurator of FIG. 1. This product choice page provides a list **60** of company and/or partner products. This page is presented automatically after the customers needs have been assessed and provides a list of products that most nearly fill the customer's needs. The product box may be manually checked, if desired, although the needs identification dialog typically results in an automatic product selection, which is identified by a check that is automatically placed in the box associated with the selected product (Puri: column 5, lines 25-35).

The Examiner further notes, as shown in Fig. 5, Puri is not limited to recommending configuration for a system after the user has selected the product, but does teach and suggest providing specification of a commodity based on "object of use" and/or "object of need."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-273-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MSG
Primary Examiner
April 3, 2006